

Remarks

Reconsideration of the present application is respectfully requested.

The objection to claim 2 is overcome by the amendment shown above.

The rejection of claims 1-4 under 35 USC 102(e) as being anticipated by Ong is respectfully traversed.

For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (emphasis added).

Claim 1 features a first die having channel and controller functions. Nowhere does Ong show that system integrated circuit (IC) 12 has a channel function. As such, that claim 1 feature is not identically shown. Therefore, claim 1 is not anticipated and is allowable. Claims 2-4 are also allowable due to their dependence on allowable claim 1.

The rejection of claims 5-15 under 35 USC 103(a) as being unpatentable over Ong in view of Miyamoto is respectfully traversed.

The Office Action states "a disc drive of the computer is inherent." However, "that which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). As taught by those cases, reliance on an inherency argument to support this obviousness rejection is inappropriate. Therefore, the rejection cannot stand. Claims 5-15 are not obvious and are allowable.

Conclusion

This Reply is believed to be responsive to all points raised in the Office action. Accordingly, prompt allowance and passage of the application to issue are earnestly solicited. Should the Examiner have any remaining questions or concerns, he/she is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

Seagate Technology LLC
(Assignee of the Entire Interest)

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Date

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